

### III. REMARKS

Claims 1-16 are pending in this application. By this response, claims 1, 4, 6, 9 and 16 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-16 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yoshida (U.S. Patent No. 6,801,546 B1), hereafter “Yoshida,” in view of Umansky (U.S. Patent No. 7,142,550 B1). In the Office Action, the Office admits that Yoshida does not disclose a method of communicating electronic mail, wherein “said electronic email data originates in an electronic mail format, and converting said electronic mail data converted into said image back into electronic mail data in the electronic mail format.” However, the Office asserts that Umansky discloses this claimed feature. In response, with respect to independent claims 1, 4, 6, 9, 12-13 and 15-16, Applicant submits that the cited references fail to teach or suggest converting on the receiver said electronic mail data converted into said image form back into electronic mail data in the electronic mail format. (*See* claim 1, and as similarly recited by claims 4, 6, 9, 12-13 and 15-16.) Instead, Umansky teaches that “...the network processing device reconverts the unsuccessfully transmitted facsimile information into an email message format for inclusion within the second email message.” Col. 11, lines 45-48. In Umansky, an email is converted to facsimile information and transmitted to one or more remote facsimile devices. (Col. 11, lines 31-33.) In the case that a portion of the facsimile data is

unsuccessfully transmitted, the original network processing device recovers the facsimile data to email data for inclusion in a second email message. (Col. 11, lines 41-48.) However, in Umansky, it is the same network processing device that first converts the first email message to facsimile information that converts the unsuccessfully transmitted facsimile information back to email data. Umansky teaches that the conversion back to email data occurs on the network processing device (original sender) after the transmission is bounced back as being unsuccessful. Nowhere does Umansky teach a message that begins as an email, is converted to facsimile, and is converted to an email message on the receiver after being transmitted over a switched line. As such, both Yoshida and Umansky fail to teach the features of the claimed invention. Accordingly, Applicant submits that the Office has failed to establish a prima facie case of obviousness and requests that the Office withdraw its rejection.

Furthermore, Applicant submits that there is no suggestion or motivation to combine the teachings of Umansky, with the facsimile/internet transmission system disclosed generally by Yoshida. While Umansky discloses generally a method for managing facsimile communications over the internet using conventional telephony communications equipment, it is incomprehensible why Umansky or Yoshida, or a person of ordinary skill in the art, would consider an invention, as disclosed in Umansky, that teaches conversion of “only those pages of a fax document that have failed to have been successfully transmitted to their fax recipient(s)”, with an invention that teaches a message that is transmitted via facsimile, is converted into an email, is sent to another facsimile machine via email, is converted into a facsimile, and is transmitted via facsimile, as taught by Yoshida. Umansky address the very specific situation in which a facsimile document has been unsuccessfully sent. However, Yoshida initially sends a

message via email. Accordingly, converting an unsuccessful initial message back to email form would add nothing to the invention as disclosed by Yoshida. As a result, Applicant submits that there is no motivation or suggestion to combine the cited references and respectfully request the withdrawal of the rejection.

With respect to dependent claims 2-3, 5, 7-8, 10-11, and 14, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

#### **IV. CONCLUSION**

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better

condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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